

REMARKS

Claims 1, 2, 4, 6, 8, 11 and 12 stand rejected under 35 USC 103(a) as being unpatentable over Tashiro in view of Leumer. Claim 7 stands rejected under 35 USC 103(a) as being unpatentable over Tashiro in view of Leumer and further in view of Buxbaum. Claims 9 and 10 stand rejected under 35 USC 103(a) as being unpatentable over Tashiro in view of Leumer and further in view of Vogt. These rejections are respectfully traversed.

First, to the extent that the Examiner relies on the inherent disclosure of Tashiro and Leumer to support the obviousness rejection of claims 1, 4 and 6, this rejection is untenable because, as aptly stated in MPEP 2141.02, at page 2100-132, "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." There is no evidence on this record that persons of ordinary skill in the art would have been aware that the characteristics set forth in formulas 1-9 of claims 1, 4 and 6, could be achieved by any combination of Tashiro and Leumer. This means that there is no basis upon which the Examiner can properly find that the invention of claims 1, 4 and 6 as a whole would have been obvious to persons of ordinary skill in the art at the time the invention was made. Tashiro and Vogt are not cited to overcome this basic deficiency in Tashiro and Leumer and thus do not suffice to complete a case of obviousness. Accordingly, the rejection of claims 1, 4, and 6 should be withdrawn. The rejection of claims 2 and 7-12, which depend from claims 1 and 6, should similarly be withdrawn.

In addition, as previously explained, Tashiro describes a flameproof polyester fiber made from a side chain type phosphoric compound copolymerized polyester. Examples of such fibers are provided in Examples 29-33 of Tashiro. However, the flameproof fibers described in Examples 29-33 are staple tow fibers, which were drawn 3.5-fold in a hot water tank at 90°C. In addition, the flameproof polyester fibers produced in Examples 1-28 were also staples tow fibers, which were drawn 3.5-fold in a hot water tank at 90°C.

As explained in the previous response, drawing a fiber after spinning affects the dyeability and abrasion resistance of the fiber. A higher draw ratio degrades the dyeability and abrasion resistance of the fiber. Accordingly, in the Examples of this application the highest draw ratio that was used was 2.8 fold. In addition, staple tow fibers are generally susceptible to high surface abrasion and are, accordingly, easily worn. As explained in the previous response, applicants have found that satisfying formulas 1-3, included in claim 1, depends upon the dyeability and abrasion resistance of the fiber. Since Tashiro only describes staple tow fibers that were drawn at a draw ratio far higher than the claimed draw ratio, a flame-retardant polyester fiber that satisfies these formulas would not be inherent to fibers produced according to Tashiro.

Leumer is directed to producing a fiber having an extremely high strength for use as an industrial material. To achieve this high strength, Leumer discloses a high total draw ratio of 4.5 to 6.0-fold. Accordingly, Leumer, like Tashiro, discloses a fiber created with a draw ratio far above the draw ratio used by applicants. Since the high draw ratios used in Leumer and Tashiro would negatively affect both dyeability and abrasion resistance of the fiber, a fiber a flame-retardant polyester fiber that satisfies the formulas would not be inherent to fibers produced according to the methods described in Tashiro and Leumer.

Finally, since Tashiro and Leumer are directed to solving different problems, using different flame-retardant agents, it is not clear why one of ordinary skill in the art would be motivated to combine these references as suggested by the Examiner.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Attorney Docket No. **358362010400**.

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